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EXAMINER

CHIN, RANDALL E

ART UNIT PAPER NUMBER

1744

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/072,148

Applicant(s)

SHELTON, JEFFERSON L.

Examiner

Randall Chin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 16-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-31 is/are allowed.
- 6) ☒ Claim(s) 1 and 10-14 is/are rejected.
- 7) ☒ Claim(s) 2-9 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The <sup>proposed</sup> drawing(s) filed on April 30, 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. For accuracy purposes, Applicant is respectfully requested to clarify/verify the dependency of withdrawn claims 17-22. For example, claim 17 depends on subsequent claim 18.

Claim 25, line 1, "23wherein" should read – 23 wherein --.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy '474.

The patent to Murphy '474 discloses a cleaning apparatus for penetrating and removing deposits from an internal wall of a tube or pipe comprising a rotary drive unit defined by hydraulic motor 84 operatively connected to a first end of a "drill" shaft 32, a honing tool or drill bit 34 (Fig. 13) suitable for drilling said deposits, attached to a second end of said drill shaft and oriented for coaxial rotation therewith (col. 4, lines 21-23), a portion of said drill shaft, intermediate said rotary drive unit and said drill bit, slidably received in a shroud or sleeve member (see optional shroud or sleeve arrangement around shaft 32 at col. 4, lines 23-25) permitting rotational and linear displacement of said drill shaft therein, and a fluid jet 62 (Fig. 13) projecting from an outer surface of said

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drill shaft still proximal said drill bit 34 (best seen in Fig. 13), said fluid jet in communication with a pressurized fluid source through said drill shaft (col. 5, lines 16-35).

As for cleaning and penetrating and removing deposits from an internal wall of a kiln, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As for claim 10, the drill shaft is selectively extensible between a retracted position, wherein said drill bit is displaced proximal said sleeve, and an extended position, wherein said drill bit displaced distal said sleeve (compare Figs. 8 and 9 and see col. 6, lines 7-17).

As for claims 11 and 13, Murphy shows "linear" actuator means which may be carriage 82 or even chains 86 for selectively positioning said drill shaft between said retracted and extended positions (see col. 5, line 62 to col. 6, line 6).

As well as claim 12 is understood, the fluid jet can be continuously maintained between the extended and retracted positions.

As for claim 14, the actuator means further comprise guide means, said guide means comprising a guide rod 74 slidably received in at least one guide loop (see

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connector tees for guides 74 in Fig. 8 but not labeled explicitly) extending from and attached to an outer surface of said sleeve member through supports 80 (Fig. 8).

#### ***Allowable Subject Matter***

4. Claims 23-31 are allowed.

Claims 2-9 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

5. Applicant's arguments filed April 30, 2004 have been fully considered but they are not persuasive.

Applicant argues that the shroud of Murphy '474 cannot slidably receive the shaft "as specified in the applicant's claims."

It is the position of the Examiner that Murphy '474 clearly discloses all of the recited subject matter, particularly, as set forth in claim 1. Claim 1 recites that a portion of the drill shaft is slidably received in a sleeve member permitting rotational and linear displacement of the drill shaft therein. In Murphy '474, a portion of said drill shaft, intermediate said rotary drive unit and said drill bit, is slidably received in a shroud or sleeve member (see optional shroud or sleeve arrangement around shaft 32 at col. 4, lines 23-25) permitting both rotational and linear displacement of said drill shaft therein. Rotational as recited in col. 5, lines 62-64 and linear as recited in col. 6, lines 7-17 by

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carriage 82. Therefore, Applicant's assertion that Murphy's shroud cannot slidably receive the shaft "as specified in the applicant's claims" is not understood. Such statement is vague. Clearly, the shroud would act as a "sleeve member" and protects or houses the shaft 32 therein. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, it should be noted that it is arguable that "a sleeve member" (claim 1, line 5) is not positively set forth in claim 1. It is suggested for completeness to positively recite the "sleeve member." It is noted, however, the recitation of "said sleeve member" in dependent claim 2, for example.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The Examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Robert Warden, can be reached at (571) 272-1281. The number for Technology Center 1700 is (571) 272-1700.

The central fax number for the organization where this application or proceeding is assigned is (703) 872-9306.



R. Chin



Randall Chin  
Primary Examiner  
Art Unit 1744